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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,449	06/27/2000	Elvin R. Lukenbach	JBP-508	4917

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EXAMINER

HARDEE, JOHN R

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/604,449

Applicant(s)

LUKENBACH ET AL.

Examiner

John R Hardee

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,3,52,53,82,83 and 85 is/are pending in the application.
- 4a) Of the above claim(s) 72-80 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 23-30 is/are allowed.
- 6) ☒ Claim(s) 2,22,52-71 and 81-85 is/are rejected.
- 7) ☒ Claim(s) 54-71, 81 and 84 is/are objected to.
- 8) ☒ Claim(s) 2,3,52,53,82,83 and 85 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on May 5, 2003 has been entered.

Election/Restrictions

2. Newly submitted claims 72-80 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: These methods may be used to make compositions which are not commensurate in scope with the composition claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 72-80 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

3. Claims 2, 3, 22-30 and 52-85 are generic to a plurality of disclosed patentably distinct species comprising water dispersible components and esters. Applicant is

Art Unit: 1751

required under 35 U.S.C. 121 to elect a single disclosed species of water dispersible component and a combination of two esters, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. During a telephone conversation with Ms. Erin Harriman on June 10, 2003 a provisional election was made without traverse to prosecute the invention of hexylene glycol as the water dispersible component and pentaerythritol tetraoctanoate and cetyl octanoate as the combination of esters, claims 2, 22, 52, 53, 82, 83 and 85. Affirmation of this election must be made by applicant in replying to this Office action. Claims 54-71, 81 and 84 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, as these claims are dependent from claim 52, with the exception of claims 54, 55 and 84, which depend from cancelled claim 1, yet these claims recite the presence of only one ester.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

Art Unit: 1751

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

6. Claims 54-71, 81 and 84 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. These claims are dependent from claim 52, with the exception of claims 54, 55 and 84, which depend from cancelled claim 1, yet these claims recite the presence of only one ester.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 54-71, 81 and 84 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are dependent from claim 52, with the exception of claims 54, 55 and 84, which depend from cancelled claim 1, yet these claims recite the presence of only one ester. It is not clear whether these claims were meant to be of "further comprising" scope, whether they were meant to modify claim 54, claim 3, or some independent claim which was omitted from the preliminary amendment, or if they were meant to recite "one of the esters" rather than

“the ester”. Rather than speculate on the intended meaning of these claims, the examiner has not treated these claims further on the merits.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 2, 22, 52, 53, 82, 83 and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah et al. US 4,980,155. The reference discloses two-phase cosmetic compositions comprising a color phase and a gel phase. An essential component of the color phase is a film forming agent at 1-30% of the composition. Preferred film forming agents include pentaerythritol tetraoctanoate and glyceryl rosinate (col. 3, lines 25-43). Another essential component of the color phase is an emulsifier. A particularly preferred emulsifier is a blend of triethanolamine and stearic acid (col. 3, lines 44-53). The emulsifier is present at 1-10% by weight of the color forming composition. The examiner notes that when these ingredients are blended in the presence of water, the product is triethanolammonium stearate, which is a soap and a foaming anionic surfactant. Another essential component is water at about 10-98% of the compositions (col. 3, lines 61-62). The compositions may include humectants at 10-30% of the composition. Hexylene glycol is a preferred humectant (col. 5, lines 20-22). Additional optional components include polyethylene glycol stearates (col. 6, lines 9-10) and water soluble resins (col. 5, lines 54+) These are polymers which will act as thickeners. Method claim 85 is drawn to the intended use of a cosmetic composition and

Art Unit: 1751

is obvious in view of the disclosure. Upon mixture of the phases, these compositions appear to have a creamy consistency. This reference differs from the claimed subject matter in that it does not disclose a composition which reads on applicant's claims with sufficient specificity to constitute anticipation.

It would have been obvious at the time the invention was made to make such a composition, because this reference teaches that all of the ingredients recited by applicants are suitable for inclusion in a cosmetic composition. The person of ordinary skill in the surfactant art would expect the recited compositions to have properties similar to those compositions which are exemplified, absent a showing to the contrary.

Allowable Subject Matter

11. Claims 3 and 23-30 are allowed. Reasons are of record in a previous office action.
12. Claims drawn to applicant's two recited esters and hexylene glycol would be allowable. The closest prior art of record is the reference relied upon above, and it does not disclose or make obvious the use of cetyl octanoate.
13. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 1751

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner, Dr. John R. Hardee, whose telephone number is (703) 305-5599. The examiner can normally be reached on Monday through Friday from 8:00 until 4:30. In the event that the examiner is not available, his supervisor, Dr. Yogendra Gupta, may be reached at (703) 308-4708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'J. Hardee', with a stylized, cursive script.

John R. Hardee
Primary Examiner
June 27, 2003